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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/602,506

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Russell Minoru Hanabusa

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EXAMINER

LEE, BENJAMIN C

ART UNIT

PAPER NUMBER

2612

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,506

Applicant(s)

HANABUSA ET AL.

Examiner

Benjamin C. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-11,13-19,21-27,29,30,32-54,60-62,65,69-74 and 86-101 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 99 is/are allowed.
6) ☒ Claim(s) 1,2,5-11,13-19,21-27,29-30, 32-37, 43-45, 47-50, 53-54, 60-62, 65, 69-70, 73 and 86-101 is/are rejected.
7) ☒ Claim(s) 38-42,46,51,52,71,72 and 74 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response To Amendment

Claim Status

1. Claims 1-2, 5-11, 13-19, 21-27, 29-30, 32-54, 60-62, 65, 69-74 and 86-101 are pending.

Claim Objections

2. Claim 97 is objected to because of the following informalities: Amended claim 97 does not show the alterations as compared to its previous version. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Claims 10-11, 17, 36, 43-44, 47-50, 53-54, 90-94 and 101 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) In claims 10-11, line 1, “the plastic” lacks antecedent basis (claim 9 has deleted “plastic”); it appears such deletion is unintentional since claims 10-11 depends on claim 9. The following prior art rejection treats claim 9 as still including “plastic” in order for the claims to make sense.

2) In claim 17, line 2, “or” should be --and--.

3) In claim 36, line 8, “and a folded-over device” should read --or a folded-over device--.

4) Claims 43-44, 47-50, 53-54 and 90-94 are similarly rejected due to dependency on rejected claim 36.

5) In claim 101, line 8, “connecting the at least one vessel to each other” is indefinite since that requires at least 2 vessels but line 3 recites “at least one vessel” which includes the embodiment of having only one vessel.

Claim Rejections - 35 USC § 102

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4. Claims 1-2, 5-9, 13-16, 18-19, 21-27, 29-30, 33-34, 37, 45, 60-62, 70, 73 and 95-96 are rejected under 35 U.S.C. 102(b) as being anticipated by Masi et al. (US pat. #5,517,180).

Masi et al. discloses:

1) claims 1 and 73: device for deterring an attack and aiding in identification of an attacker (Abstract) comprising: at least one evidence material (col. 4, lines 28-34; col. 6, lines 55-65; col. 7, lines 42-48) retained by a person other than the victim (attacker);

2) claim 2: vessel (ampule in Figs. 3-5, 8-10);

3) claim 5: open or partially open vessel (710 of Fig. 7);

4) claim 6: closed vessel (Figs. 4-5 and 10);

5) claim 7: a tube (i.e. elongated) or bite actuated vessel ("ampule" is pressure actuated regardless of the source of pressure is from the hand or mouth bite), or any item capable of containing the evidence material and made of any suitable material (Figs. 1-5 and 7-11);

6) claims 8, 13-14, 16: leak indicating fluid in multi chamber vessel (one or more of the colored/opaque evidence materials according to col. 7, lines 41-43 in multi-chambered embodiments additionally act as leak indicating material);

7) claim 9: plastic vessel (col. 7, line 4);

8) claims 15 and 21: fluid comprises particles (col. 4, lines 28-34; col. 6, lines 55-65; col. 7, lines 42-48, whereby pepper spray fluid, glowing liquid, colored paint constitute particles suspended in liquid);

9) claim 18: liquid or powder evidence material (col. 4, lines 28-34; col. 6, lines 55-65; col. 7, lines 42-48);

10) claim 19: dissimilar evidence materials (col. 4, lines 28-34; col. 6, lines 55-65; col.

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7, lines 42-48);

11) claims 22-27, 30: at least one but not all of the evidence material particles, liquid and/or powder further comprise at least one identification code/marker or manufacturers device registration procedure providing for maintenance of a permanent history of each device manufactured (evidence materials such as paint in Masi et al. of particular color of particular composition made by a particular manufacturer at a particular plant, date as a particular batch inherently constitutes identifiable unique telltales/permanent history including color, compositions, particle shapes, patterns, time frame or length of time since manufactured, etc. usable as identification codes or markers individually identifiable by evidence experts, and furthermore that manufacturers keep identification tools of such material to identify their materials by manufacturing lot numbers using telltales, while other materials such as water content do not include such identifiable marker);

12) claim 29: life time of evidence material is self limiting (materials such as pepper spray are degradable over time);

13) claims 33 and 60-61 (claimed features are in the alternative by an “or” in the claims): tool “for” (i.e. intended use) obtaining and storing samples of tissue, skin, hair or body fluids (device housing portions of Figs. 1 & 8 including edges and rods 28, 814, 816 while striking an attacker in an intended use constitutes a tool that can be used to (i.e. the claimed “for”) obtain and retain/store one or more such samples), the tools being detachably connected to a surface in a patterned arrangement (patterned/arrange particularly to provide said housing);

14) claim 34: the vessel is either filled with or empty of the evidence material in Masi et al.;

15) claim 37: the tool is “capable” of removing and holding tissue, skin, body fluid or bone sample when used in striking an attacker's body, the tool comprising the surface.

16) claim 45, the surface of tip where ampule nozzle is located constitutes a striking/scraping surface as a tool, and the nozzle constitutes the claimed evidence material discharge/bleed channel in Fig. 2, for example;

17) claim 62: pin 28 constitutes the tool that is not visible.

18) claim 70: removable cover 18, plus consideration of claim 33 for tool as intended use;

19) claim 95: the claimed method for deterring an attack and aiding in identification of an attack comprising the steps of: manufacturing a vessel (ampule) capable of housing evidence material (identifying spray liquid); placing the evidence material into the vessel; equipping the person to be protected with the vessel containing the evidence material; applying pressure to the vessel or breaking the vessel or tearing the vessel or puncturing the vessel or opening the vessel (using trigger), and spreading the evidence material over the person to be protected and the attacker (see Abstract and Figs. 1-8, whereby the person is being spread with the evidence material as well as the attacker due to proximity and the spreading action of the spray);

20) claim 96: met by consideration of claims above, plus Figs. 1-5 and 8.

5. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Charlot, Jr. et al. (US 5031287).

Charlot, Jr. et al. discloses the claimed: device (Fig. 1) comprising at least one evidence material and a multi-chamber vessel (col. 3, line 52 to col. 4, line 14); a penetrating device or tool (pin 14) for obtaining and retaining samples of tissue, skin, hair, bone or body fluid

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(intended use of pin 14); and an identification code (EAS electronic tag of col. 5, line 61 to col. 6, line 2 having an identifiable frequency response), wherein the claimed for deterring an attack and aiding in identification of an attacker constitutes an intended use of the device when used/activated in the presence of a potential attacker.

Claim Rejections - 35 USC § 103

6. Claims 10-11, 32, 35, 65, 69 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masi et al.

1) Regarding claim 10, while Masi et al. did not specify the type of plastic used, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to choose any of the known claimed types of plastics having properties that meet the characteristics required in operation of the Masi et al. vessel.

2) Regarding claim 11, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to use textured surface on the plastic of the vessel for easy handling and manipulation such as during insertion, removal or addition of evidence material into the vessel.

3) Regarding claim 32, Masi et al. discloses using a vessel having first, second and third chambers (Figs. 3-5, 9) with at least two evidence materials so that upon puncturing the materials in the chambers are jointed/mixed to be activated to provide an evidence marking fluid, and that various different types of materials associated activations can be used (col. 4, lines 28-34; col. 7, lines 43-45). It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to use evidence materials that require mixing with water and an additional empty chamber for proper activation, or making use of only 2 of the existing 3 chambers for a

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particular evidence material activation that requires evidence material in one chamber and water in another only, in a device such as taught by Masi et al. without unexpected results.

4) Regarding claim 35, since the device constitutes the tool, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that when manufactured and/or marketed, such device having a code such as a Universal Product Code constitutes the claimed tool comprising a code.

5) Regarding claim 65, Masi et al. discloses use of glowing/colored and/or pungent fluid without specifying the specific types (col. 7, lines 38-47).

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to implement such glowing/colored and/or pungent fluid in Masi et al. using one or more of the claimed types.

6) In considering claim 69, Masi et al. met all of the claimed subject matter as in claim 2, wherein:

Masi et al. discloses a vessel of somewhat cylindrical shape with a pressure applying surface so that upon pressure application the vessel expands outwardly and in the direction of an obstacle (806, 808 or 12) for opposing the pressure thereby forcing the release the evidence material through the nozzles, whereby the resulting pressure crushes the brittle chamber separating walls (see Figs. 3-5 and 8-10).

However, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that a somewhat rectangular shaped vessel having bottom and top surfaces connected to each other with first and second walls at the ends would have worked just as well in a device such as taught by Masi et al., and furthermore that instead of brittle separating walls that

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crush under pressure, flexible/pliable separating walls in combination of sharp edged cutting tools can be used to release and mix the evidence materials since they provide the same effect of breaking the chamber walls to mix and expel the evidence materials.

7) Regarding claim 97, Masi et al. render obvious all of the claimed subject matter as in the consideration of claim 65, plus col. 8, lines 54-62 and figures of Masi et al.

7. Claims 86-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masi as in claims 1-2 or 33 in view of Perreau et al. (US 5,777,553).

In the art of EAS tags, Perreau et al. teaches the known use of a radio frequency identification transponder device (RFID) as an EAS tag (col. 3, lines 49-51) having an antenna and an inherent unique electrical identification code to protect uniquely identifiable objects from unauthorized use/removal (Abstract), wherein the RFID device is electrically active when responding to an interrogation signal, and electrically inactive when not being interrogated.

1) Regarding claims (86-89), in view of the teachings by Masi and Perreau et al., it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to include a known RFID device of Perreau et al. in Masi to protect it against unauthorized use/removal, whereby additional mechanical identity code can be added as redundancy for the electrical identity code.

8. Claims 100-101 are rejected under 35 U.S.C. 103(a) as being obvious over Charlot, Jr. et al. (US 5031287).

Regarding claims 100-101: Charlot, Jr. et al. discloses the claimed method as shown by Figs. 1-2, whereby it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that when the shirt/clothing in Fig. 2 is being worn by a person, the device

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method constitutes attaching the vessel containing the evidence material to the person to be protected, wherein the claimed for deterring an attack and aiding in identification of an attacker constitutes an intended use of the device when used/activated in the presence of or by a potential attacker, and that instead of attaching the device to the person using the pin and clutch setup of Charlot, Jr. et al., a pin and clasp can be used to provide the same function, whereby the pin and clasp constitutes the claimed strand connector.

Allowable Subject Matter

9. Claim 99 is allowed.
10. Claim 98 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
11. Claims 17, 36, 43-44, 47-50, 53-54 and 90-94 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
12. Claims 38-42, 46, 51-52, 71-72 and 74 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Improper Amendments

13. Amendment to the specification and drawings filed 6/27/06 (to cancel new matter) does not comply with acceptable amendment practices. Cancellation of specific portions of the specification should be done under an "Amendment to the specification" heading followed by instructions (instead of reciting the text with strike-throughs) or better yet as in this case with lengthy amendments, with a substitute specification. Cancellation of the figures should be done

under a separate “Amendment to the drawings” heading followed by instructions to cancel those figures.

Response To Arguments

14. Applicants arguments are not deemed persuasive.

1) The claimed language makes no such argued distinction between “evidence material” and Masi’s “identification material” in which the marking fluid marks or identifies the assailant.

2) Claim 2 does not specify that it could not be a “complex device” like Masi’s.

3) Claim 5: Masi’s ampule in Fig. 7 allows expelling of the fluid by having a nozzle or opening, thus meeting the claimed “open or partially open vessel”.

4) Claim 8: Masi’s visually identifiable liquid “escapes” or “leaks” out of the ampule/vessel during use, thus the liquid is inherently indicating the escapement/leak therefore constituting the claimed leak indicator.

5) Claim 15: Particles in, e.g. identifying paint in Masi, meets the claimed type for identification purposes.

6) Claims 22-27 and 30: As indicated in rejection, “evidence materials such as paint in Masi et al. of particular color of particular composition made by a particular manufacturer at a particular plant, date as a particular batch inherently constitutes identifiable unique telltales/permanent history including color, compositions, particle shapes, patterns, time frame or length of time since manufactured, etc. usable as identification codes or markers individually identifiable by evidence experts, and furthermore that manufacturers keep identification tools of such material to identify their materials by manufacturing lot numbers using telltales, while other

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materials such as water content do not include such identifiable marker”. As such, there is no difference between Masi and the claimed invention.

7) Claim 33: The claimed “for” capability of the tools constitutes intended use as indicated in the rejection; any hard object with edges as does the Masi device as depicted in the figures when striking a person will retain at least identifiable trace amount of tissue, blood, skin, cells, DNA, other bodily fluid, hair, etc.

8) Claim 34: Evidence material as defined/interpreted in the rejection of claim 1 can include the substance inside the ampule of Masi when it is filled.

9) Claim 37: If evidence material stays on the tool, then the tool “retains and holds” it (claim does not say “store”).

10) Claim 45: See rejection above and rebuttal to claim 33 argument. Claim language is broad enough in breadth and scope to warren the rejection’s interpretation.

11) Claim 62: Pin 28 as a whole that constitute a “tool” is not visible, i.e. not visibly identifiable as a tool.

12) Claim 70: Safety cap of 18 of Masi is a removable cover, plus consideration of claim 33 for tool as intended use.

13) Claim 84: Pin 28 of Masi is small in diameter and elongated that has the design for penetration.

14) Claim 95: Claim does not specify that pin-pulling action is not required; furthermore the pin may be initially pulled in Masi so that during use it doesn’t have to.

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15) Claims 1-2 rejected over Charlot: Pin 14 of Charlot can be opened, and thus can be used to collect or retain samples when for example poking, swinging or scraping against any person.

16) Claims 10 and 35: By definition of a 35 USC 103(a) rejection Masi doesn't have to teach all the claim limitations.

17) Claim 11: "Purpose" constitutes intended use of the Masi device and furthermore that the Masi device can be used that way as indicated in the rejection.

18) Claim 69: Obviousness rejection doesn't require Masi to teach all claimed limitations. Also, when pressure is applied to (i.e. squeezed) ampule of Masi made of flexible material, the pressure portions of the ampule external wall are pushed inward to create internal pressure, while external wall portions downstream are being expanded as internal fluid content is forced by this internal pressure towards them.

19) Claim 86: The Perreau reference is relevant since it is still pertinent to identification of the object that the RFID tag is attached to, as in "Radio Frequency Identification Device" (RFID). Reducing theft was one of the resulting intended effects of this identification feature. Identification of the attacker/victim is also pertaining to "identification" of the object that the tag is being attached to. It is not claimed, nor inherent, in claim 86 that the RFID tag "would not require employing printed circuit board technology as in Perreau" as applicant argued.

20) Claims 100-101: See "intended use" and complete obviousness rejection of claims 100-101 above. The feature of Charlot in which the vessel is being broken upon tampering to

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release and spread its contents, even when the tampering is not strong enough to detach, requires that “the strength of the attachment devices exceeding the vessel breaking strength” as claimed.

21) In conclusion, applicant’s arguments are not deemed persuasive, and the rejection is maintained.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

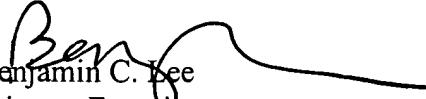
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin C. Lee whose telephone number is (571) 272-2963. The examiner can normally be reached on Mon -Th 9:00Am-5:30Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Daniel Wu can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Benjamin C. Lee
Primary Examiner
Art Unit 2632

B.L.